

THIS DECISION IS NOT
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OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Caruso Property Management, Inc.

Serial No. 78241396

Jane Shay Wald of Irell & Manella LLP for Caruso Property Management, Inc.

Barbara Rutland, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Walters, Drost and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On April 23, 2003, Caruso Property Management, Inc.
(applicant) filed an application to register the mark shown
below on the Principal Register for:

Dissemination of advertising material for others;
preparing and placing advertisements for others;
promoting the goods and services of others through
promotional offers; promoting the sale of goods and
services of others through the distribution of printed

material; [providing business marketing information],¹
in International Class 35, and

Retail shopping center services, in International
Class 36.



Applicant asserts both first use and first use of the mark
in commerce in both classes on October 1, 2001.

The examining attorney refused registration in only
Class 35 on the ground that the specimen failed to show use
of the mark with the Class 35 services. Applicant
responded by providing a substitute specimen. The
examining attorney rejected the substitute specimen for the
same reason in a final refusal, and applicant appealed.
For the reasons set forth below, we reverse.

¹ Applicant submitted an amendment with its appeal brief
requesting the deletion of "providing business marketing
information" from the Class 35 services. The examining attorney
objected to the timing of the amendment citing Trademark Rule
2.142(d), 37 C.F.R. § 2.142(d), which provides, "The record in
the application should be complete prior to the filing of an
appeal." The rule does not preclude the amendment applicant
proposed. Applicant has offered the amendment without any
condition or qualification. Accordingly, we have entered the
amendment. Our decision here is not dependent on entry of the
amendment.

By way of background, applicant explains that it operates a large outdoor shopping center known as "THE GROVE" in Los Angeles. The shopping center, "resembl[es] a beautiful village more than the prototypical shopping mall."

The substitute specimen at issue consists of a brochure which prominently displays "THE GROVE" service mark alone and in conjunction with applicant's design mark shown above which is the subject of this application. The brochure also includes some pictorial and word games directed at children and three detachable coupons for three businesses which are located in the mall, PACIFIC THEATRES AT THE GROVE, WISHING BEAR and FAO SCHWARTZ FIFTH AVENUE. The face of each coupon includes an offer of a discount or free item from the business featured on that particular coupon and a background consisting of a large silhouette of applicant's design mark shown above. The other side of each coupon displays "THE GROVE" word mark and a background consisting of the same large silhouette of applicant's design mark.

In her evaluation of the specimen the examining attorney states, "These brochures are clearly targeted to the shopping mall patrons, not to the business owners within the shopping mall. They do not offer advertising

services to the business owners. They do not offer promotional services. They do not offer any of the services listed in the International Class 35 recitation." On this basis the examining attorney concludes that the specimen does not show use of the mark in Class 35.

On the other hand applicant notes that all of the services in Class 35, as identified, are rendered "for others." Applicant notes further, "These others, as is evident from the substitute specimen, are the tenants within applicant's shopping center. Applicant's substitute specimen for Class 35 shows the mark in connection with each of these services."

Section 1(a) of The Trademark Act requires that an applicant submit "specimens or facsimiles of the mark as used" as part of the application. 15 U.S.C. § 1051(a)(1). The Act provides further that a mark is "in use in commerce . . . on services when it is used or displayed in the sale or advertising of the services." 15 U.S.C. § 1127. The Trademark Rules likewise specify, "A service mark specimen must show the mark as actually used in the sale or advertising of the services." 37 C.F.R. § 2.56(b)(2). The Board has observed that use in the "rendition" of services should be viewed as an element of the "sale" of services under Section 45 of the Act. In re Red Robin Enterprises,

Inc., 222 USPQ 911, 913 (TTAB 1984). See also In re
Metriplex Inc., 23 USPQ2d 1315, 1316 (TTAB 1992); In re
Eagle Fence Rentals, Inc., 231 USPQ 228, 230 (TTAB 1986).

In this case we believe the substitute specimen, applicant's brochure, shows use of the mark in the rendering of the applicant's Class 35 advertising services, specifically in relation to at least the following services: "dissemination of advertising material for others"; "promoting the goods and services of others through promotional offers"; and "promoting the sale of goods and services of others through the distribution of printed material."

Accordingly, we conclude that the substitute specimen is acceptable for the Class 35 services, as currently identified, in their entirety. The brochure itself includes the design mark shown above which is the subject of this application numerous times, as well as the associated word mark "THE GROVE." The brochure also includes coupons redeemable at businesses within the shopping center. These businesses are "the others" for whom applicant renders the Class 36 "retail shopping center services" and "the others" for whom applicant renders its Class 35 advertising services.

The examining attorney argues that the brochures are not proper specimens because they are directed to the customers of the shopping center and not to the tenant businesses. In doing so the examining attorney fails to consider the possibility that an acceptable specimen may show use of a mark only in the rendering of the services rather than in the advertisement of the services. Furthermore, on the facts, the examining attorney assumes an overly narrow view of how the brochure will be used. The very nature of the brochure, as described by applicant, leads to the logical conclusion that the applicant's tenant businesses will see the mark on the full brochures as they are distributed to potential customers of their businesses and/or when the coupons are presented to the tenant businesses for redemption by customers. In this way the tenant businesses will encounter the mark in the rendering of the applicant's advertising service for their benefit.

Throughout the brief the examining attorney argues that the specimen must explicitly refer to the services. Here too the examining attorney takes too narrow a view. The Board has recognized that the service need not be referenced explicitly even in a specimen which purports to show use of a mark in the advertisement or promotion of the services. See In re International Environmental Corp., 230

USPQ 688, 691 (TTAB 1986)(specimen showing use of mark in surveys used to promote service with no mention of "distributorship services" found acceptable). In the case of a specimen intended to show use of the mark in the sale or "rendering" of the service, the specimen need not and often will not include an explicit reference to the service. In re Metriplex Inc., 23 USPQ2d at 1316.

The examining attorney relies on In re Advertising & Marketing Development Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987). In that case the Federal Circuit reversed the Board's affirmance of an examining attorney's rejection of a specimen for advertising services. The court found that the applicant's use of its mark in correspondence with potential clients offering its advertising services was acceptable to show use for the purpose of registration for advertising services, even though its clients also used the mark in the advertisement of their own services. Id. at 2015. The examining attorney attempts to contrast that case with this one by noting that here there is no letter or similar specimen directed to the potential clients for the advertising service showing use of the mark and referring to an advertising service. Here again, the examining attorney fails to consider the possibility of use of the mark in the

rendering of the advertising service, a type of use which was neither alleged nor considered in In re Advertising & Marketing Development Inc. Here, applicant's mark identifies applicant as the source of the brochures, the advertising vehicle in question, not the source of its client tenants' goods and services.

The examining attorney also relies on In re Admark, Inc., 214 USPQ 302 (TTAB 1982). In that case, the specimens showed that the applicant, an advertising agency, was licensing marks, such as the mark at issue, "THE ROAD AUTHORITY," for use by clients in advertising campaigns for the clients' goods and services. In that case the Board found that the specimen only showed use of the mark by the applicant's licensee to identify its services, retail tire and auto accessory store services, and not to identify an advertising service.

The facts before us are distinguishable from those in the Admark case. Most importantly, the totality of the record here establishes that the mark applicant seeks to register is one applicant uses to identify its own services, in particular, its advertising services rendered on behalf of the tenant businesses. The record indicates that the mark, as used on the specimen, would be associated with applicant, the shopping center operator, by the tenant

businesses, and with the advertising service rendered by applicant for the benefit of those tenant businesses.²

In conclusion, applicant's brochure, which it submitted as a substitute specimen, shows use of the applied-for mark in the rendering of its advertising services in Class 35 for the benefit of its clients, the tenant businesses in its shopping center.

Decision: The refusal to register the mark in International Class 35 for failure to provide a proper specimen is reversed.

² The examining attorney also cites In re Monograms America Inc., 51 USPQ2d 1317 (TTAB 1999)(letterhead specimen found unacceptable to support use with consulting services where no reference to such services was present) and In re Adair, 45 USPQ2d 1211 (TTAB 1997)(label specimens applied to finished decorated tree found unacceptable to show use with design services related to the trees). Both cases are distinguishable on their facts from this case.